

THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Andrea Hughs-Baird, et al.  
Appl. No.: 10/086,014  
Conf. No.: 3796  
Filed: February 28, 2002  
Title: GAMING DEVICE HAVING IMPROVED OFFER AND  
ACCEPTANCE GAME WITH MASKED OFFERS  
Art Unit: 3714  
Examiner: Robert E. Mosser  
Docket No.: 0112300-610

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANTS' CORRECTED APPEAL BRIEF**

Sir:

Appellants submit this Corrected Appeal Brief in response to the Notice of Non-Compliant Appeal Brief dated July 9, 2007, in support of the Notice of Appeal filed on and received by the U.S. Patent and Trademark Office on January 9, 2007. This Appeal is taken from the Final Rejection dated October 13, 2006.

Please charge deposit account number 02-1818 for any fees which are due in connection with this Response to Non-Compliant Appeal Brief and this Corrected Appeal Brief.

**I. REAL PARTY IN INTEREST**

The real party in interest for the above-identified patent application on appeal is IGT by virtue of an Assignment dated February 26, 2002, and recorded on February 28, 2002 at the United States Patent and Trademark Office at reel 012661, frame 0369.

## **II. RELATED APPEALS AND INTERFERENCES**

Appellants, Appellants' legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

### **III. STATUS OF CLAIMS**

Claims 11 to 17, 21 and 22 stand allowed. Claim 19 has been cancelled. Claims 1 to 10, 18 and 20 stand rejected. Therefore, Claims 1 to 10, 18 and 20 are being appealed in this Brief. A copy of the appealed claims is attached in the Claims Appendix.

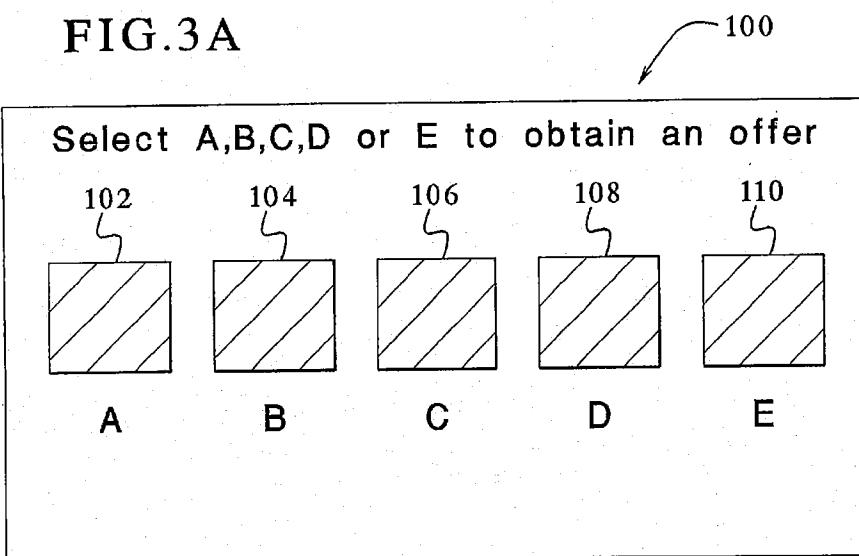
**IV. STATUS OF AMENDMENTS**

None.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The following is a concise summary of the invention (and is substantially taken from pages 2 to 19 of the present application).

The gaming device and method disclosed in the present application provides the player an opportunity to directly and independently select each of the offers (instead of having the processor randomly select the offers for the player). One embodiment disclosed in the present application is best explained in connection with the following illustration taken from the present application:



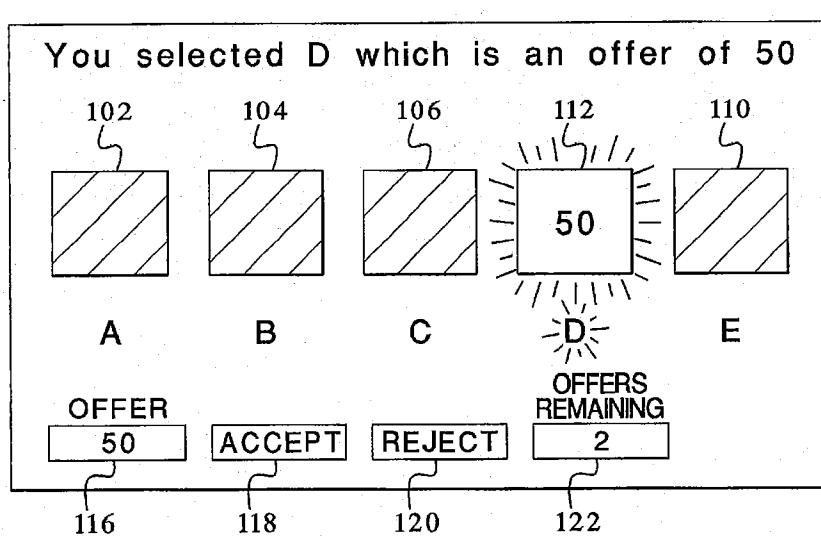
In this example embodiment, the gaming device displays a plurality of masked selections (e.g., labeled A, B, C, D and E). The gaming device includes a plurality of offers (not shown to the player) which are each directly and individually associated with separate ones of these masked selections. The gaming device enables the player to select one of the masked selections and reveals the offer associated with the player picked masked selection. The gaming device enables the player to accept or reject the revealed offer. By picking one of the masked selections, the player directly picks the offer which the player can accept or reject.

If the player accepts the offer directly and individually associated with the player picked selection, the gaming device provides the value of the offer to the

player and the game ends. If the player rejects the offer, the gaming device directly and individually reassociates the offers (including the rejected offer) with the masked selections, and enables the player to make another selection from the plurality of masked selections. This process repeats until the player accepts an offer directly associated with a player picked selection or the offer is a final offer (which is provided to the player). Thus, each offer provided to the player is independent of the previous offers because each offer is directly and individually associated with one of the masked selections.

An example of this is described in connection with Fig. 3B of the present application (reproduced below). The player picks masked selection labeled D and the gaming device reveals the offer of 50 which is directly and individually associated with the player picked selection. The gaming device enables the player to accept or reject the revealed offer of 50. If the player accepts the revealed offer of 50, the gaming device provides the value of 50 credits to the player and ends the game. If the player rejects the revealed offer of 50, the gaming device directly and individually reassociates all of the offers (including the rejected offer of 50) with the 5 masked selections and enables the player to again pick one of the 5 masked selections to reveal an offer.

FIG.3B



Accordingly, the gaming device and method of the present invention provides an improved offer and acceptance game in which the player directly selects the offers presented to the player to accept or reject.

A further summary of the invention by way of reference to the drawings and specification for each of the independent claims and each means plus function claim follows.

Claim 1	Drawings	Specification
A gaming device comprising:	Figs. 1A, 1B & 2	Page 7, line 4 to page 11, line 12
a game including:	Figs. 3A & 3B	Page 3, lines 17 to 18; Page 12, lines 4 to 7
(i) a plurality of offers, wherein said plurality of offers are payable to a player, and	Figs. 3A & 3B	Page 3, lines 20 to 25; page 13, lines 10 to 18
(ii) a plurality of player selectable masked selections;	Figs. 3A & 3B	Page 3, line 21; page 12, lines 10 to 12
a display device;	Figs. 1A, 1B & 2	Page 9, lines 1 to 13
an input device;	Figs. 1A, 1B & 2	Page 10, lines 7 to 14
a memory device storing a plurality of instructions; and	Fig. 2	Page 9, line 18 to page 10, line 6
a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:	Fig. 2	Page 9, line 18 to page 11, line 5

(a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections,	Figs. 3A & 3B	Page 12, line 12 to page 13, line 5
(b) enable the player to select one of said selections,	Figs. 3A & 3B	Page 13, lines 10 to 12;
(c) reveal the offer directly and individually associated with the selected selection to the player,	Fig. 3B	Page 13, lines 12 to 16
(d) enable the player to accept or reject the revealed offer,	Fig. 3B	Page 14, lines 1 to 10
(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player; and	Figs. 3A & 3B	Page 14, lines 12 to 15; Page 12, line 12 to page 13, line 5
(f) if the player accepts said revealed offer, pay said revealed offer to the player.	Figs. 1A & 1B	Page 14, lines 10 to 12

Claim 18	Drawings	Specification
A method for operating a game of a gaming device, said method comprising, for each play of the game, the steps of:	Figs. 1A, 1B & 2	Page 7, line 4 to page 11, line 12
(a) triggering a play of the game;	Figs. 3A & 3B	Page 3, lines 17 to 18; Page 12, lines 4 to 7
(b) directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein said plurality of offers are each payable to a player;	Figs. 3A & 3B	Page 12, line 10 to page 13, line 18
(c) displaying said plurality of selections;	Figs. 3A & 3B	Page 3, line 21; page 12, lines 10 to 12
(d) revealing one of said offers directly and individually associated with one of said selections to the player;	Figs. 4A, 4B & 4C	Page 15, lines 20 to 21
(e) enabling the player to pick one of the selections;	Figs. 3A & 3B	Page 13, lines 10 to 12;
(f) revealing said offer directly and individually associated with said picked selection to the player;	Fig. 3B	Page 13, lines 12 to 16
(g) enabling the player to accept or reject said revealed offer;	Fig. 3B	Page 14, lines 1 to 10
(h) providing the offer to the player if the player accepts said offer or if the offer is a last offer; and	Figs. 1A and B	Page 14, lines 10 to 12

(i) repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player.	Figs. 3A & 3B	Page 14, lines 12 to 15; Page 12, line 12 to page 13, line 5
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Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the references numerals and citations below, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the references numerals and specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

1. Claims 1 to 10, 18 and 20 stand rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,648,754 to Baerlocher et al. (referred to herein as "Baerlocher").
2. Claims 1 to 10, 18 and 20 stand rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for awarding a selection, does not reasonably provide enablement for paying a selection.

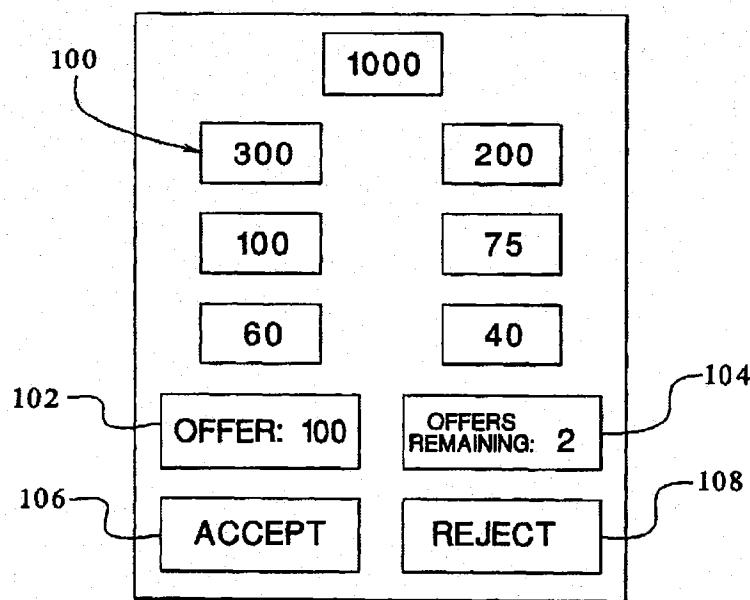
## VII. ARGUMENT

### 1. The Examiner has Incorrectly Rejected Claims 1 to 10, 18 and 20 under 35 U.S.C. §102(e).

#### A. Gaming Machine Prior Art

Many gaming machines known prior to the present invention had a primary or base game and a secondary or bonus game. These known gaming machines required the player to make a wager to play the primary or base game (such as a conventional slot game having a plurality of reels). In the play of the primary or base game, the player either won an award or did not win an award. Many of these known gaming machines provided the secondary or bonus game to the player if a triggering event occurred in the play of the primary game. In the play of many known secondary or bonus games, the player usually wins an award; and the secondary or bonus game is played to determine the amount of the award won by the player.

One well known gaming machine is the TOP DOLLAR™ gaming machine, which is manufactured by IGT, the assignee of the present application. An advertisement for this gaming machine was submitted in the Information Disclosure Statement filed on June 4, 2002 for the present application. This gaming machine includes an offer and acceptance bonus game. This known offer and acceptance bonus game is very generally described in the background of the present invention on page 3, lines 2 to 10. The present invention is easiest explained after explaining this known offer and acceptance bonus game. This known offer and acceptance bonus game is easiest explained in connection with the illustration below.



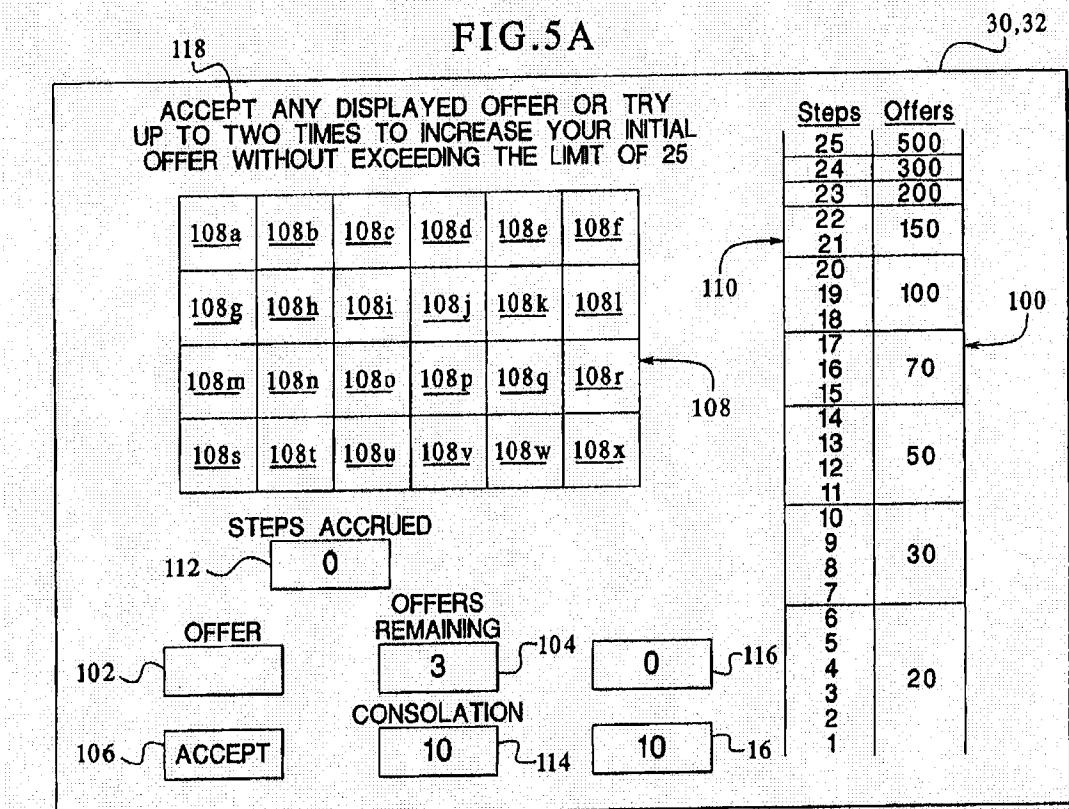
In the known offer and acceptance bonus game, the gaming device processor randomly selects an offer from a plurality of offers of differing values (e.g., 1000, 300, 200, 100, 75, 60 and 40). An offer can include one or more of these values. The gaming device indicates the processor selected offer to the player. If the selected offer is not a final offer, the gaming device enables the player to accept or reject the indicated offer. If the player accepts the offer or the offer is a final offer, the gaming device pays to the player an award equal to the offer and the bonus game ends. If the player rejects the offer, the gaming device repeats the process until either the selected offer is accepted by the player or a final selected offer is paid to the player. The TOP DOLLAR™ gaming machine provides the player up to three selected offers (which the player can accept or reject) before providing a final selected offer to the player (if the player rejects the three previous selected offers). The player does not make inputs or otherwise take part in the selection of the offers. The processor of the gaming machine randomly selects each of the offers.

While bonus games have become popular in casinos, many players become bored with playing the same games over and over again. Accordingly, there is a well established continuing need in the gaming industry for gaming design manufacturers to develop new and different games.

**B. Baerlocher Provides an Offer and Acceptance Game in which Each of the Offers is Determined through a Multiple Step Process and Each Offer After the First Offer is Dependent on Each of the Previous Offer Determinations**

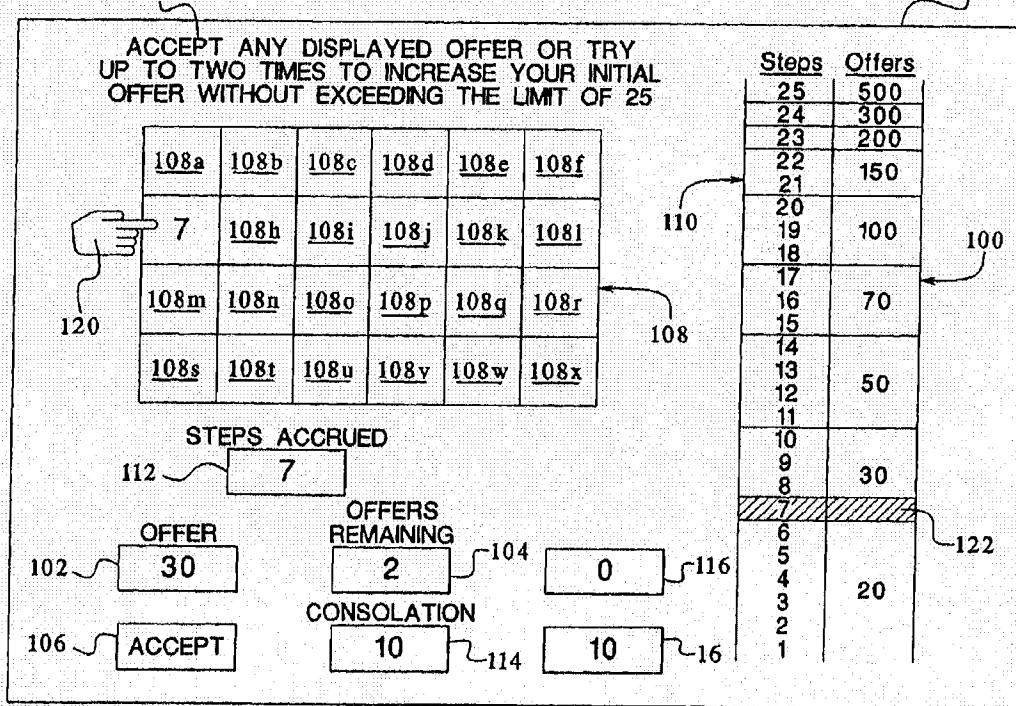
The Examiner rejected the appealed claims under 35 U.S.C. §102(e) as being unpatentable over Baerlocher. Baerlocher is also assigned to IGT, the assignee of the present application. Baerlocher discloses a gaming device having an offer and acceptance game which determines each offer to make to the player for acceptance or rejection through a multiple-step process, and wherein each offer after the first offer is based on each of the previous offer determinations. Baerlocher is easiest explained using the figures of Baerlocher.

Fig. 5A of Baerlocher (reproduced below), discloses a plurality of player selectable masked selections 108a to 108x. The gaming device processor randomly associates different amounts or numbers of steps with each of the masked selections. In this embodiment, the numbers of steps associated with the masked selections can range from 1 to 25 steps.



The Baerlocher gaming device enables a player to pick one of the masked selections from the plurality of player selectable selections 108a to 108x. For example, as seen in Fig. 5B (reproduced below), the player picks selection 108g.

FIG. 5B



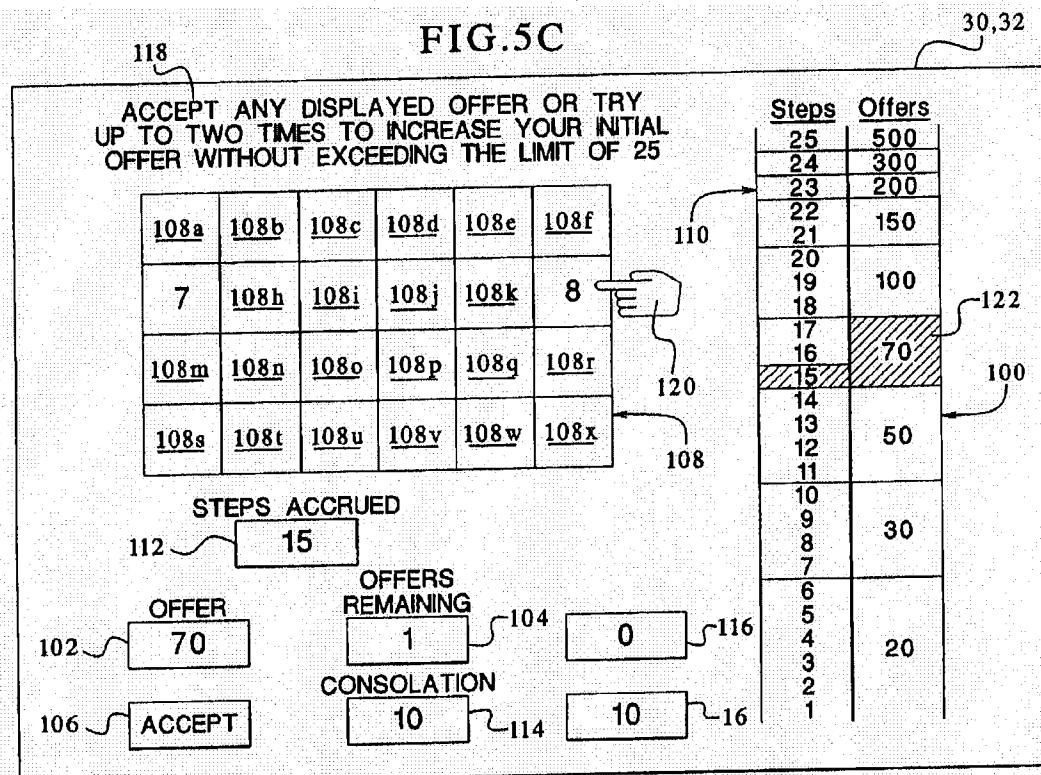
The gaming device reveals the number of steps associated with the player picked selection 108g. As seen in Fig. 5B, the gaming device reveals that selection 108g is associated with 7 steps. The gaming device adds the revealed number of steps associated with the player picked selection to the Steps Accrued meter 112. As seen in Fig. 5B, the 7 steps associated with selection 108g are accumulated in the Steps Accrued meter 112.

The Baerlocher gaming device determines the offer associated with the accumulated number of steps which at this point is 7. As seen in the chart on the right side of Fig. 5B, the gaming device determines that the accumulated 7 steps are associated with an offer of 30. Each offer is directly associated with one or more accumulated number of steps and not directly associated with one of the player selectable masked selections.

The Baerlocher gaming device enables the player to accept or reject the determined offer. In this example, the gaming device enables the player to accept or reject the offer of 30. If the player accepts the offer of 30, the gaming device

pays a value of 30 credits to the player and the game ends. If the player rejects the offer of 30, since the player has at least one remaining offer, the gaming device enables the player to pick another selection. In this example, the player rejects the offer of 30.

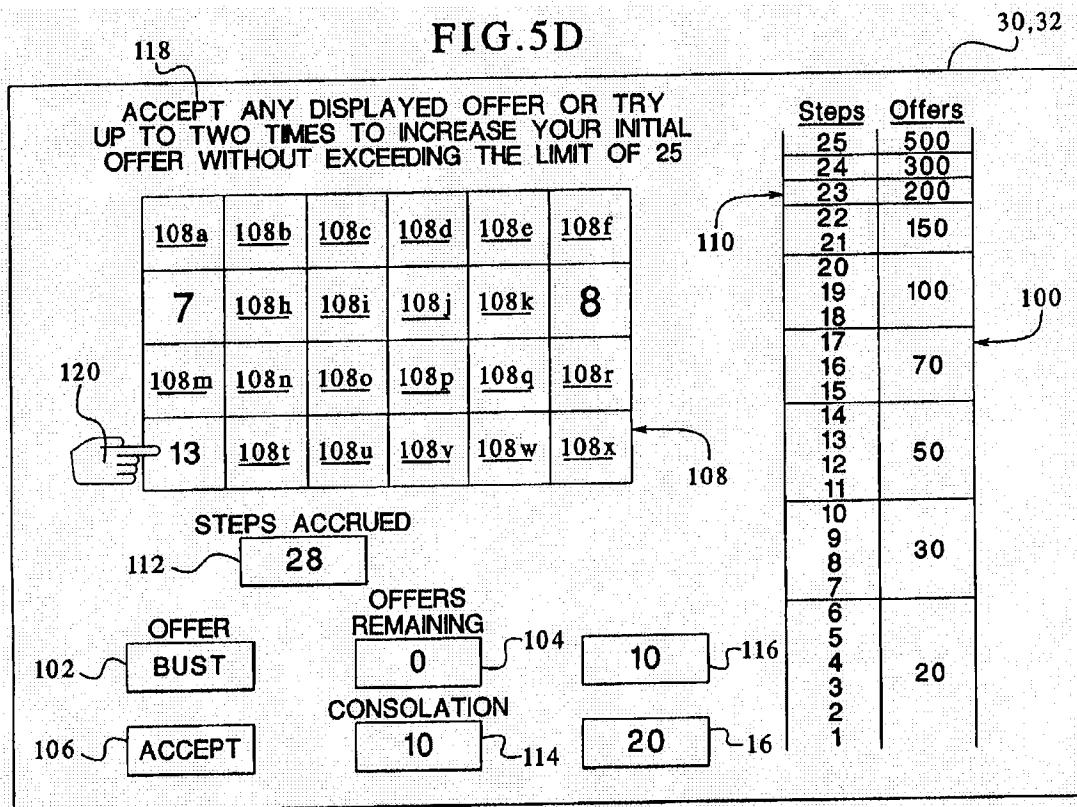
Fig. 5C of Baerlocher (reproduced below) illustrates that the player then picks selection 108I.



The gaming device reveals that picked selection 108I is associated with 8 steps. The revealed 8 steps are added to the previously revealed 7 steps to result in a total of 15 accumulated steps which are shown in the Steps Accrued meter 112. The gaming device determines that the 15 accumulated steps are associated with an offer of 70. The gaming device enables the player to accept or reject the offer of 70 (in the same manner as described above). It should be appreciated that after the first offer, the accumulated number of steps utilized to determine each offer is based on the number of steps associated with each of the player's

previously picked selections. In the above example, the second offer (after the first offer is rejected) is dependent on the 8 steps associated with picked selection 108i and on the 7 steps associated with previously picked selection 108g. In this example, the player rejects the offer of 70 associated with the accumulated 15 steps.

Fig. 5D of Baerlocher (reproduced below) illustrates that the player picks selection 108s.



The gaming device reveals that picked selection 108s is associated with 13 steps. The revealed 13 steps are added to the previously accumulated 15 steps to result in a total of 28 accumulated steps which are displayed in the Steps Accrued meter 112. The 28 accumulated steps exceed a termination limit of 25 steps and the player is provided no more offers to accept or reject. The gaming device provides a consolation award of 10 credits to the player (as illustrated in the Consolation meter 114) and the game ends. In the Baerlocher game, after the first offer, a

chance exists with each rejected offer and each picked selection that the accumulated number of steps associated with the multiple picked selections will be greater than the termination limit of 25 steps. Thus, the likelihood of going over the termination limit increases with each picked selection and with each subsequent pick, the player risks that they will only win the consolation award. In other words, the accumulation of the numbers of steps associated with the picked selections in combination with the termination limit associated with a number of accumulated steps creates a dynamic wherein after each picked selection, the player decides whether to accept the current offer or pick another selection and risk exceeding the termination limit (and only winning the consolation award). Thus, with each rejected offer, the chances of exceeding the termination limit increase for each subsequently picked selection.

The above describes the primary embodiments of Baerlocher. Baerlocher also discloses three alternative embodiments.

In one alternative embodiment in Baerlocher, if the player rejects the offer, the gaming device reshuffles or redistributes the numbers of steps associated with the selections 108a through 108x after each offer. (See col. 10, lines 36 to 38).

In another alternative embodiment in Baerlocher, the game alternatively does not enable the player to reselect a previously picked selection and in turn reveals or unmasks all previously picked selections throughout the game. (See col. 10, lines 33 to 36).

In another alternative embodiment in Baerlocher, the game enables the player to pick the same selections 108a through 108x two or more times and enables the same number of steps to be generated whether or not the player picks the same selections a plurality of times. (see col. 10, lines 40 to 44).

In the primary embodiments described above and in each of these alternative embodiments:

1. the offers of Baerlocher are not directly and individually associated with the player selectable masked selections;

2. the different offers of Baerlocher are associated with different numbers of accumulated steps;

3. each offer of Baerlocher provided to the player to accept or reject is determined based on the number of steps accumulated in the Steps Accrued meter; and

4. after the first offer of Baerlocher is rejected, each offer is based on the sum of the steps associated with each of the previously picked selections.

**C. Baerlocher Does Not Directly and Individually Associate the Offers with the Selections, such that Each Offer is Directly and Individually Associated with a Separate One of the Selections as in Claims 1 to 10, 18 and 20**

Claim 1 is directed to a gaming device comprising, amongst other elements:

a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:

(a) **directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections,**

\* \* \*

(e) **repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player.**

Similarly, Claim 18 is directed to a method for operating a game of a gaming device, said method comprising, amongst other elements, for each play of the game, the steps of:

(b) **directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein said plurality of offers are each payable to a player;**

\* \* \*

(i) **repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player.**

Contrary to this express claim language, the Baerlocher offers are not directly and individually associated with the selections, such that each offer is directly and individually associated with a separate one of the selections. As described above, in Baerlocher, certain of the offers are associated with the same number of accumulated steps and certain of the offers are associated with different numbers of accumulated steps. The individual amounts or numbers of steps are associated with the selections. The Baerlocher offers are thus clearly not directly and individually associated with the selections. For this reason alone, the rejection under section 102 of these Claims 1 and 18 (and the claims which depend therefrom) should be reversed.

Moreover, in Baerlocher, if the player rejects the revealed offer, the revealed offer is not directly and individually reassociated with one of the masked selections for at least one subsequent selection by the player as in steps 1 (e) and 18(i). For at least this additional reason, the rejection under section 102 of Claims 1 and 18 (and the claims which depend therefrom) should be reversed.

**D. After the First Offer is Rejected, Baerlocher Does Not Reveal the Offer Directly and Individually Associated with the Selected Selection as in Claims 1 to 10, 18 and 20**

Claim 1 is directed to a gaming device comprising, amongst other elements:

a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:

**(b) reveal the offer directly and individually associated with the selected selection to the player;**

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**(e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player.**

Similarly, Claim 18 is directed to a method for operating a game of a gaming device, said method comprising, amongst other elements, for each play of the game, the steps of:

**(f) revealing said offer directly and individually associated with said picked selection to the player;**

\*\*\*

**(i) repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player.**

Contrary to this express claim language, the Baerlocher gaming device does not reveal the offer directly and individually associated with the selected selection to the player after the player rejects a first offer. In Baerlocher, for each selection picked by the player, the gaming device reveals the number of steps associated with the selection picked by the player. The number of steps associated with the picked selection are accumulated. The accumulated number of steps are used to determine the offer made to the player for acceptance or rejection. After the player rejects a first offer, any subsequent offer is based on not only the number of steps associated with the player's currently picked selection, but also on each of the numbers of steps associated with the player's previously picked selections. Thus, even if somehow this claim language reads on Baerlocher for the first offer, after the first offer is rejected, the Baerlocher gaming device clearly does not perform this step of revealing for each subsequent offer. For at least this reason alone, the rejection under section 102 of Claims 1 and 18 (and the claims which depend therefrom) should be reversed.

### **E. The Examiner's Analysis is Incorrect**

During prosecution, the Examiner appears to have taken many positions which are incorrect. For example, at one point, the Examiner appears to have interpreted the offers in Baerlocher to be the offers in the Claims. At another point, the Examiner appears to have interpreted the steps in Baerlocher to be the offers in the Claims. Under either of these interpretations, Baerlocher does not anticipate the claimed invention for at least the reasons set forth below.

Moreover, the Examiner appears to be setting forth additional analysis, which is not fully understood. Below is a response to this analysis based on an apparent understanding of the Examiner's reasoning. The Examiner is invited to write a clear step-by-step analysis (preferably using an example based on the Baerlocher game) in the Examiner's Answer to explain his position so that a proper response can be provided in Appellant's Reply.

#### **i. If the Offers of Baerlocher are Considered to be the Offers of the Claims, then the Selections of Baerlocher are Not Directly and Individually Associated with the Offers**

Under a first interpretation of Baerlocher, the Examiner appears to reason that the offers of Baerlocher are the offers in the Claims. If so, this first interpretation does not support the section 102 rejection because Baerlocher does not disclose that its offers are directly and individually associated with its selections which are pickable by the player. Rather, the different offers in Baerlocher are respectively associated with different numbers or amounts of steps. That is, the offers in Baerlocher are at best indirectly associated with the selections (via the intermediary of the steps). It is noted that in the April 4, 2006 Office Action, the Examiner acknowledged this indirect association by stating that the "association' between the masked selections and the offer would be defined by the mapping of the resultant number of accrued steps for any given selection."

Moreover, in the October 13, 2006 Final Office Action, the Examiner states that:

[o]n page 11 of the remarks by Applicant, the Applicant contends that the present claims include a *direct* and *individual* association between a selection and the value associated with said selection and that this relationship defines the claimed invention over the previously presented first interpretation. Respectfully, the Applicant is interpreting this new claim language of a narrower scope than presented. A direct and individual association as utilized in the presented claims sets forth only a minimum of a one to one correspondence between a selection and a value but not a sole, unique or unrepeated relationship. By way of a brief example, the selection of elements A' and B' can both be directly and individually associated with the common value 3 hence while player's selection of A' or B' may result in the achievement of the value 3, the selection of A' does not imply the selection of B' and nor would the selection of B' imply the selection of A'.

This reasoning is difficult, if not impossible to understand. To the extent understood, the Examiner appears to be reasoning that in Baerlocher certain offers are associated with different numbers of accumulated steps. For example, in Baerlocher, the offer of 20 is associated with both 2 steps and 3 steps. As seen in Fig. 4B, since a player can pick selection 108n associated with 2 steps and then the player can pick selection 108i associated with 1 step to accumulate to 3 steps, the Examiner appears to be saying that the offer of 20 is directly and individually associated with both selections 108n and 108i in that play of the game. This example of a Baerlocher game play still does not meet the claim language that each offer is directly and individually associated with a separate one of the selections.

For at least this additional reason alone, the rejection under section 102 of these Claims 1 and 18 (and the claims which depend therefrom) should be reversed.

**ii. If the Amounts or Numbers of the Steps of Baerlocher are the Offers of the Claimed Invention, then the Offers of Baerlocher are Not Payable to a Player**

Under a second interpretation of Baerlocher, the Examiner appears to reason that the amounts or number of the steps of Baerlocher are the offers in the Claims. If so, this second interpretation does not support the section 102 rejection because Baerlocher does not disclose that the amounts or numbers of the steps are payable to a player. In Baerlocher, the offers are payable to the player (if the player accepts a revealed offer), but the amounts or number of the steps are not payable to the player. For example, as seen in Fig. 5B of Baerlocher, the player's picked selection 108g revealed 7 accrued steps. In this example, the amount or number of 7 (associated with the revealed number of steps) is not payable to the player, but rather the offer of 30 (associated with the 7 steps) is payable to the player (if the player accepts the offer of 30). Accordingly, the amounts or numbers of the steps in Baerlocher can not be interpreted as the offers to reject the claims.

In the October 13, 2006 Final Office Action, the Examiner states that:

[o]n Page 11 of the remarks by Applicant, the Applicant contends that the present claims include the feature of paying elements to the player not provided for in the previously presented second interpretation. While it is noted the prior art does set forth a set of paying an award separate from the steps (col. 7: 5-16) it additionally refers to the accrual of steps. These steps are awarded and equivalently paid through the play of the game and shown as Steps Accrued (Elm 112). While these steps are later redeemed for an associated reward corresponding to the number of steps accrued in the time between the awarding of these steps and their redemption they are none the less the result of the player's action throughout the game and contain an intermediate value in so much as they are eventually redeemed for a credit value prize.

By stating that the number of accrued steps are awarded because they contain an intermediate value that is eventually redeemed for a credit value prize, the Examiner appears to be equating the offers in Baerlocher (i.e., the Examiner's

"intermediate value redeemed for a credit value") with the offers in the Claims. However, interpreting the Baerlocher offers as being the offers of the Claims is contradictory to the Examiner's underlying argument that the amounts or numbers of the Baerlocher steps are the offers of the Claims.

The Examiner can either interpret the offers in Baerlocher or the amounts or numbers of the steps in Baerlocher as the offers of the Claims, but not both at the same time. It is clearly improper for the Examiner to interpret the amounts or numbers of the Baerlocher steps as the offers of the Claims (and then upon a showing that the amounts or numbers of the steps are not payable to the player), to simultaneously interpret the Baerlocher offers as the offers of the Claims.

For example, the October 13, 2006 Final Office Action stated that Baerlocher includes a processor operable for each play of the game to "(a) directly and individually associate said values with said selections" and "(c) reveal the value/offer directly and individually associated with the selected selection to the player".

As described above, if the offers in Baerlocher are interpreted as the offers of the Claims, then unlike the gaming devices and methods of operating a game of a gaming device of Claims 1 to 10, 18 and 20, in Baerlocher each offer is not directly and individually associated with a separate one of the selections. On the other hand, if the amounts or numbers of the steps in Baerlocher are interpreted as the offers of the Claims, then as described above and unlike the gaming devices and methods of operating a game of a gaming device of Claims 1 to 10, 18 and 20, the offers in Baerlocher are not payable to the player (and subsequently paid if the player accepts the revealed offer).

For at least these reasons, the rejection under section 102 of these Claims 1 and 18 (and the claims which depend therefrom) should be reversed.

## **2. The Examiner has Incorrectly Rejected Claims 1 to 10, 18 and 20 under 35 U.S.C. §112, First Paragraph.**

The October 13, 2006 Final Office Action stated that:

Claims 1 to 10, 18 and 20 stand rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for awarding a selection, does not reasonably provide enablement for paying a selection. The specification does not reasonably provide enablement for paying a selection. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. **The specification as originally filed provides for the awarding of an offer to the player** however the Applicant now uses and argues the term paying as proposed distinction between the presently claimed invention and the prior art as applied. As this term is relied upon for by the Applicant to provide a distinction from the prior art in their remarks dated August 1, 2006 and there appears to be no prior support for this distinction in the application as originally filed. (emphasis added).

The Examiner's argument are not fully understood because the pending claims do not include the element of paying a selection. The claim language of Claim 1 states "pay said revealed offer to the player." The claim language of Claim 18 states "providing the offer to the player." The specification provides enablement for paying a revealed offer to the player. For example page 14, line 10 of the specification states that: "[i]f the player accepts the offer, the gaming device provides the player with the offer, the player cannot obtain any more offers and the bonus game terminates."

Moreover, page 8, line 19 of the specification states that:

A player may cash out and thereby receive a number of coins corresponding to the number of remaining credits by pushing a cash out button 26. When the player cashes out, the player receives the coins in a coin payout tray 28. The gaming device 10 may employ other payout mechanisms such as credit slips redeemable by a cashier or electronically recordable cards which keep track of the player's credits.

Accordingly, these rejections of Claims 1 to 10, 18 and 20 should be reversed.

It is therefore respectfully submitted that the rejections of all of the claims should be reversed, and such decision is respectfully requested.

Respectfully submitted,

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## VIII. CLAIMS APPENDIX

1. A gaming device comprising:
  - a game including:
    - (i) a plurality of offers, wherein said plurality of offers are payable to a player, and
    - (ii) a plurality of player selectable masked selections;
  - a display device;
  - an input device;
  - a memory device storing a plurality of instructions; and
  - a processor adapted to communicate with the display device and the input device, said processor operable to execute said instructions to operate with said display device and said input device, for each play of the game, to:
    - (a) directly and individually associate said offers with said selections, such that each offer is directly and individually associated with a separate one of the selections,
    - (b) enable the player to select one of said selections,
    - (c) reveal the offer directly and individually associated with the selected selection to the player,
    - (d) enable the player to accept or reject the revealed offer,
    - (e) repeat steps (a) to (d) at least once if said player rejects said revealed offer, wherein if the player rejects said revealed offer, for said repeat of step (a) said revealed offer is directly and individually reassociated with one of said masked selections for at least one subsequent selection by the player; and
    - (f) if the player accepts said revealed offer, pay said revealed offer to the player.
2. The gaming device of Claim 1, wherein said plurality of offers are randomly selected from at least one pool of offers.

3. The gaming device of Claim 1, wherein said processor is adapted to randomly determine the offer associated with each selection.
4. The gaming device of Claim 1, wherein the number of offers is equal to the number of selections.
5. The gaming device of Claim 1, wherein the number of offers is greater than the number of selections.
6. The gaming device of Claim 1, wherein the number of offers is less than the number of selections.
7. The gaming device of Claim 1, wherein said processor is adapted to associate one of said offers with each of said selections.
8. The gaming device of Claim 1, wherein said processor is adapted to reassociate each of said offers with said selections after the player has rejected a preset number of revealed offers.
9. The gaming device of Claim 1, wherein each of said offers is only associated with one selection.
10. The gaming device of Claim 9, wherein said offers may be associated with a plurality of selections.

11. A gaming device having a game comprising:
  - a plurality of values, wherein each of said values is greater than zero;
  - a plurality of player selectable selections;
  - a display device;
  - a processor which communicates with said display device, associates said values with said selections wherein each selection is associated with one of said values, displays to a player the association between at least one of the values associated with one of the selections and said selection, causes the display device to display a rearrangement of the selectable selections in a manner discernable by the player prior to the player's selection of one of the selectable selections, wherein after the rearrangement of the selectable selections on the display, each selection remains associated with said previously associated value, enables the player to select one of the selections, and provides the player the value associated with the selected selection.
12. The gaming device of Claim 11, wherein said processor causes the display device to reveal the values associated with non-chosen selections.
13. The gaming device of Claim 11, wherein said processor causes the display device to reveal the maximum value associated with said selections prior to enabling the player to select one of said selections.
14. The gaming device of Claim 11, wherein said processor causes the display device to reveal the minimum value associated with said selections prior to enabling the player to select one of said selections.
15. The gaming device of Claim 11, wherein said processor randomly determines which value associated with said selections to reveal to the player prior to enabling the player to select one of said selections.

16. The gaming device of Claim 11, wherein said processor causes the display device to reveal a plurality but not all of values associated with said selections prior to enabling the player to select one of said selections.

17. The gaming device of Claim 11, which includes means for enabling the player to cause the processor to re-reveal a revealed value associated with said selections prior to enabling the player to select one of said selections.

18. A method for operating a game of a gaming device, said method comprising, for each play of the game, the steps of:

- (a) triggering a play of the game;
- (b) directly and individually associating a plurality of offers with a plurality of selections, such that each offer is directly and individually associated with a separate one of the selections, wherein said plurality of offers are each payable to a player;
- (c) displaying said plurality of selections;
- (d) revealing one of said offers directly and individually associated with one of said selections to the player;
- (e) enabling the player to pick one of the selections;
- (f) revealing said offer directly and individually associated with said picked selection to the player;
- (g) enabling the player to accept or reject said revealed offer;
- (h) providing the offer to the player if the player accepts said offer or if the offer is a last offer; and
- (i) repeating steps (b) through (h) if the player rejects said offer and the offer is not the last offer, wherein if the player rejects said revealed offer, for said repeat of step (b) said revealed offer is directly and individually reassociated with one of said selections for at least one subsequent selection by the player.

19. Canceled

20. The method of Claim 18, wherein the offer revealed to the player is the maximum offer.

21. A method for operating a game of a gaming device, said method comprising the steps of:

- (a) triggering the game;
- (b) associating a plurality of values with a plurality of selections, wherein each of said values is greater than zero and each selection is associated with one of said values ;
- (c) displaying said plurality of selections;
- (d) revealing one of said values associated with one of said selections to the player;
- (e) displaying a rearrangement of the selections in a manner discernable by a player prior to the player's pick of one of the selections, wherein after the rearrangement of the selections, each selection remains associated with said previously associated value;
- (f) enabling the player to pick one of the selections; and
- (g) communicating said value associated with said picked selection to the player.

22. A gaming device operable under control of a processor, said gaming device comprising:

- a game controlled by the processor;
- a plurality of offers in the game, wherein each of said offers is greater than zero and payable to a player;
- a plurality of player selectable selections in the game; and
- a display device operable to display the game;

    wherein said processor is programmed to operate with the display device to control a play of the game by:

- (a) directly associating said offers with said selections, wherein each selection is associated with one of said offers;
- (b) enabling the player to select one of said selections;
- (c) revealing the offer associated with the selected selection;
- (d) enabling the player to accept or reject the revealed offer;
- (e) if the player accepts the revealed offer, providing the revealed offer to the player;
- (f) if the player rejects the revealed offer, causing the display device to display a rearrangement of the selectable selections in a manner discernable by the player prior to the player's subsequent selection of one of the selectable selections, wherein after the rearrangement of the selectable selections by the display device, each selection remains associated with said previously associated offer;
- (g) enabling the player to pick one of the selections; and
- (h) providing the player the offer associated with the picked selection.

## IX. EVIDENCE APPENDIX

None.

**X. RELATED PROCEEDINGS APPENDIX**

None.